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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,494	10/30/2001	Jesse Donaldson	PALM-3674	1309
41066 7590 02/04/2009 MURABITO, HAO & BARNES, LLP TWO NORTH MARKET STREET, THIRD FLOOR SAN JOSE, CA 95113				
EXAMINER				
LEE, WILSON				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/021,494

**Applicant(s)**

DONALDSON ET AL.

**Examiner**

Wilson Lee

**Art Unit**

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **Continued Examination Under 37 CFR. 1.114**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued under 37 CFR 1.114, and fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/26/08 has been entered.

### **Drawings**

Drawings filed on 10/30/01 are objected because they are informal.

### **Response to Arguments**

Applicant's arguments filed on 11/26/08 have been fully considered but they are not persuasive.

### **Argument #1**

Applicant argues that Mills fails to disclose "wherein said user selection comprises a user interaction with a user interface of said portable electronic device", and "a user selection of a file to copy".

Examiner respectfully disagrees.

The main concept of Mills invention is directed to a memory expansion module (adaptor) connected to a portable device such as PDA, digital cell phone or handheld devices. It is no doubt that all PDAs, digital cell phone or handheld devices including Mills provide an user interface to user to select the file he or she wants to copy to a memory card through a memory expansion module.

The following citations in Mills support Examiner's initial positions:

1) In paragraph [0078], Mills teaches that his invention is "for use with a PDA and digital cell phone". And "an expansion memory coupled to the expansion module/card provides storage for Internet downloads. ". The "downloads may include email, MP3 audio, or streaming video, which is stored to non-volatile expansion memory."

2) In paragraph [0046], lines 16-21, Mills teaches "PDA to provide user interface functions using the display and input devices of the PDA for controlling the storing and playback of digitally encoded media."

3) In paragraph [0035], lines 12-24, Mills teaches "the present invention ... permitting easy user field selection and upgrades of memory used in conjunction with the expansion card."

4) In paragraph [0159], lines 11-16, Mills teaches "The use of labeled, color-coded... may provide the best solution for ease of use for users needing to select a particular program or data set from many reconfiguring an application specific expansion card."

As shown above, the PDA or handheld device connected with Mills invention are all portable devices.

Further, the PDA or handheld device provides user the user interface to select a file such as email, MP3 audio, streaming video for downloads, and store them to a field selected by user in an expansion memory. Each file such as email, MP3 audio, streaming video must be identified by a filename, indicator, icon or a string of characters

displayed on the PDA for user to select for storing in the memory. Therefore, "in response to a user selection" does exist in Mills.

### **Argument #2**

Applicant argues that Payne fails to disclose "wherein said user selection comprises a user interaction with a user interface of said portable electronic device."

However, this limitation is taught by the primary reference, Mills.

### **Claim Rejections – 35 U.S.C. 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 33, 34, 39, 40, 45, 46, 51, 52, 56, 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Mills et al. (US 2004/0048503), a continuation of 09/439,966.

Regarding Claim 33, Mills et al discloses a method of copying files comprising:

storing a plurality of location identifiers comprising a location identifier, wherein said plurality of location identifiers comprises of a removable memory (inherently storing the identifiers or indexes of the files for retrieval) wherein said plurality of location identifiers further comprises a location identifier<sup>1</sup> of a memory of a portable electronic device, and wherein

said removable memory is detachably coupled to said portable electronic device (page 3, paragraphs 0035-0038),

in response to a user selection of said file to copy to said removable memory, associating said location identifier of said removable memory with said file (See paragraph 0035 lines 12-24, paragraph 0046 lines 16-21, paragraphs 0078, 0159 lines 11-16 and Response in Argument #1 for explanation), wherein said user selection comprises a user interaction with a user interface of said portable electronic device (See Response in Argument #1 for explanation); and

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<sup>1</sup> "Location identifiers" or indexes are inherent features in all memory or storage including Mills removable memory for pointing the stored data.

In Computer Dictionary, by Microsoft Press third Edition, *Index* (or so called location identifier) is defined as "a listing of keywords and associated data that point to the location of more comprehensive information, such as files and records on a disk or record keys in a database." Or "in data storage and retrieval, to create and use a list or table that contains reference information pointing to stored data."

Therefore, the Mills memory must inherently contain or store the indexes such as reference characters or numbers, filenames, indicators for indicating the location of the memory or pointing or locating the data for the retrieval and playback. Particularly, the underlined shows that files and records on a disk and table that contains reference information. Any skilled in the files and recording along with the index or identifier are stored and the reference information along with the index or identifier is stored in the table.

The following citations in Mills support Examiner's initial positions:

1) In paragraph [0161], lines 4-6, Mills teaches "a player uses the removable memory to store and playback digitally encoded media such as music, audio, or video."

2) In paragraph [0171], lines 6-10, Mills teaches "application is receiving location data (I/O data-com link to GPS receiver), retrieving map data...."

As shown above, Mills teaches that the encoded file and map data can be played back or retrieved. It supports Examiner's initial position indicating Mills must comprise the so called location identifiers being stored to locate or point out the files in order to playback or retrieving the stored data.

in response to said associating said location identifier of said removable memory with said file (see footnote #1), automatically copying said file from said memory of said portable electronic device (paragraph 0046) to said removable memory<sup>2</sup> (See paragraphs 0045, 0046). Also see *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) for limitation "automatically".

Regarding Claim 34, Mills et al discloses removable memory is at least one of SD (Secure digital) card ("private removable media/memory", line 12 of paragraph 0033), a MMC ("MMC", line 6, paragraph 0133), a Compact Flash card ("Compact Flash Card", line 2 of paragraph 0010; "removable flash-based memory", line 1 of paragraph 0159) and a Smart Media card ("Smart Cards, SIM Cards", line 8 of paragraph 0175). (Also see paragraphs 0044, 0051, 0052, 0057, 0058 for details).

Regarding Claims 39, 45, 51, 56, these claims are rejected on grounds corresponding to the arguments and rejection given above for rejected claim 33 is similarly rejected.

Regarding Claims 40, 46, 52, 57, these claims are rejected on grounds corresponding to the arguments and rejection given above for rejected claim 34 is similarly rejected.

### Claim Rejections – 35 U.S.C. 103

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<sup>2</sup> In paragraph 0046, lines 20-22 of Mills, Mills teaches "the playback of the digitally encoded media is initiated **automatically** upon insertion of the removable memory." It is followed by the storing, or so-called copying to method (in lines 5-15, paragraph 0046). Thus, the copying (storing) a file (from an expansion card) to a removable memory is automatically. It is initiated automatically upon insertion of the removable memory. Further, since Mills does not disclose any human intervene in the copying process, it is considered as automatic.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-38, 41-44, 47-50, 53-55, 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills et al. (US 2004/0048503), a continuation of 09/439,966, in view of Payne et al. (USP 7,003,327).

Regarding Claims 35-37, Mills teaches "PDA's display/input-tablet provides for virtual controls and visual indicators for the application" (paragraph 0147) and "perform O/S related functions in conjunction with expansion modules" (paragraph 0149).

Although Mills does not literally disclose displaying said plurality of location identifiers comprising texts or icons, Payne (7,003,327) teaches a mobile device (Col. 3, line 55 to Col. 4, line 4) embodying an advantage such as displaying the identifiers for retrieving information (the word "retrieving" indicates the information has been stored). Payne also discloses, for instances, email contact identifiers (in text) (Col. 11, lines 13-20), and visual identifiers (in icons) (272, 274, 276, 278, 280, 284, 270) on the display of the cell phone (in Figure 2G). Further, since Payne displays the identifiers, such identifiers are also at least stored in the RAM before being displayed.

It would have been obvious to one of ordinary skill in the art to provide identifiers or icon as location identifiers in the PDA, digital cell phone or handheld device using with the expansion card of Mills in order to provide advantageous convenient way for user as taught by Payne to select the files for retrieval or storage. Such "displaying a



plurality of location identifiers..." would have given those skilled in the art the tools to process issues regarding portable devices more efficiently. This gives user the advantage of copying data to the proper more accurately.

Regarding Claim 38, Mills teaches "PDA's display/input-tablet provides for virtual controls and visual indicators for the application" (paragraph 0147) and "perform O/S related functions in conjunction with expansion modules" (paragraph 0149).

Although Mills does not literally disclose displaying a visual indicator associated with files, Payne (7,003,327) teaches a mobile device (Col. 3, line 55 to Col. 4, line 4) embodying an advantage such as displaying the identifiers for retrieving information (the word "retrieving" indicates the information has been stored). Payne also discloses, for instances, icons identifiers (272, 274, 276, 278, 280) and other identifiers (284, 270) on the display of the cell phone (in Figure 2G) for users to choose. Further, since Payne displays the identifiers, such identifiers are also at least stored in the RAM before being displayed.

It would have been obvious to one of ordinary skill in the art to provide icon identifiers as visual indicators display in the PDA, digital cell phone or handheld device using with the expansion card of Mills in order to provide advantageous convenient way for user as taught by Payne to select the files for retrieval or storage. Such "visual indicator" would have given those skilled in the art the tools to process issues regarding portable devices more efficiently. This gives user the advantage of copying data to the proper more accurately.

Regarding Claims 41-43, 47-49, 53-54, 58, 59, these claims are rejected on grounds corresponding to the arguments and rejections given above for rejected claims 35-37 are similarly rejected.

Regarding Claims 44, 50, 55, 60, these claims are rejected on grounds corresponding to the arguments and rejection given above for rejected claim 38 is similarly rejected.

### **Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Wilson Lee whose telephone number is (571) 272-1824.

Papers related to the application may be submitted by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The official fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

1/31/09

/Wilson Lee/  
Primary Examiner, Art Unit 2163